

REMARKS

Foreign Priority:

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and acknowledging receipt of the certified copy of the priority document.

Information Disclosure Statement:

Applicant also thanks the Examiner for initialing and returning the Form PTO/SB/08 A & B filed on June 26, 2003, thus indicating that the reference listed thereon has been considered.

Claim Rejections:

Claims 1, 3-12, 14-21, 23-25, 27-36, 38-45, and 47-50 are all of the claims pending in the present application, and currently all of these claims stand rejected.

35 U.S.C. § 102(b) Rejection – Claims 12, 14-15, 17-18, 36, 38-39, 41-42 and 49-50:

Claims 12, 14-15, 17-18, 36, 38-39, 41-42 and 49-50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by newly applied reference U.S. Patent No. 4,664,995 to Horgan et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

Horgan discloses that the electrically conductive ground strip layer comprises a film forming binder, conductive particles, crystalline silica particles dispersed in the film forming binder and a chemical reaction product of an amino-silane bi-functional coupling agent with both the film forming binder and the crystalline particles.

However, in the present invention, crystalline silica particles and a chemical reaction product of an amino silane bi-functional coupling agent are not essentially included. In the

present invention, the resin composition “consists essentially of” a polyamide resin and an inorganic filler for reinforcement. *See e.g.* claim 12. It is for at least this reason that the present invention and Horgan differ from each other in both their composition and effects.

Moreover, Applicant submits that Horgan fails to disclose, teach or suggest having a base body which has a cylindrical shape and is made of a conductive resin composition. *See e.g.* claims 12, 36 and 49. Applicant notes the Examiner’s comments regarding this claim feature. Namely, the Examiner indicated that this feature was entitled to no patentable weight. However, as shown in the previous section, Applicant has amended these claims to more positively recite this claim feature. As such, Applicant submits that Horgan fails to disclose a base body for a photosensitive drum which has a base body having a cylindrical shape and made of a conductive resin composition, of the present invention. Further, there is no disclosure of a resin composition which consists essentially of a polyamide resin and an inorganic filler for reinforcement. *See e.g.* claims 12, 36 and 49.

In view of the foregoing comments, Applicant submits that Horgan fails to disclose each and every feature of the above claims. Therefore, Horgan fails to anticipate the claimed invention, as required under the provisions of 35 U.S.C. § 102(b). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(b) rejection of these claims.

35 U.S.C. § 102(e) Rejection – Claims 8-11:

Claims 8-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,011,090 to Sakogawa et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

The Sakogawa reference discloses using a resin composition which comprises a resin and a conductive filler. The resin contains a styrene type thermoplastic elastomer and/or an olefin type thermoplastic elastomer. Therefore, regardless of the embodiment disclosed by Sakogawa a thermoplastic elastomer is used.

In the present invention, as set forth in claim 8, a polyamide resin is used. *See* claim 8. Applicant submits that it is known that a polyamide resin is different than a thermoplastic elastomer. As such, Sakogawa's disclosure of a thermoplastic elastomer fails to disclose, teach or suggest the polyamide of the present invention.

In view of the foregoing, Applicant submits that Sakogawa fails to disclose each and every aspect of the claimed invention. Namely, there is no disclosure regarding the use of a polyamide. Therefore, Sakogawa fails to anticipate the claimed invention under the provisions of 35 U.S.C. § 102(e). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(e) rejection of claims 8-11.

35 U.S.C. § 103(a) Rejection – Claims 1, 3-5, 25 and 27-29:

Claims 1, 3-5, 25 and 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuura and Nishimura references. In view of the following discussion, Applicant respectfully traverses the above rejection.

Matsuura discloses using a conductive sheet comprising an organic polymer sheet and a conductive layer, wherein the conductive layer comprises at least one thin metal oxide layer having a thickness within the range of 5 to 1000Å, and is made from a metal selected from a specific group.

However, as shown in the previous section, claims 1 and 25 have been amended to indicated that the resin composition “consists essentially of” a resin base and a conductive agent. As such, the present claims 1 and 25 are not taught or suggested by Matsuura in view of Nishimura. Namely, the presence of the thin metal oxide layer in Matsuura takes Matsuura out of the scope of the present claims. Further, Nishimura fails to teach or suggest the removal of the thin metal oxide layer from the Matsuura composition. Thus, the above composition fails to teach or suggest the present invention, as set forth in claims 1 and 25.

Moreover, Nishimura fails to disclose, teach or suggest the combination of a polyamide resin and a lower water absorption resin. In particular, Nishimura does not disclose, teach or suggest the combination as set forth in claims 1 and 25.

In view of the foregoing, Applicant submits that the above combination fails to teach or suggest each and every feature of the present invention, as set forth in claims 1 and 25. As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims. Further, as claims 3-5 and 27-29 depend on these claims, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection – Claims 6, 7, 30 and 31:

Claims 6, 7, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuura in view of Nishimura, in further view of Coran. However, as these claims depend on claims 1 and 15, respectively, and because Coran fails to cure the deficient teachings of both Matsuura and Nishimura with regard to these claims, Applicant submits that these claims are also allowable, at least by reason of their dependence.

Moreover, Coran discloses a blend of plastic and cured particulate rubber, such as EPDM/PP Blend and EVA/Nylon blend. Because of the teachings regarding the use of these materials, Coran teaches away from using a polyamide resin, as is used in the present invention. Therefore, there would have been no motivation to one of ordinary skill in the art to combine the teachings of Coran with both Matsuura and Nishimura, to achieve the present invention. There is no teaching or suggestion in Coran regarding the use of a polyamide resin.

35 U.S.C. § 103(a) Rejection – Claims 16 and 40:

Claims 16 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horgan in view of Yoshinaka. However, since claims 16 and 40 depend on claims 49 and 50, respectively, and because Yoshinaka fails to cure the deficient teachings of Horgan, with respect to these claims, Applicant submits that claims 16 and 40 are allowable, at least by reason of their dependence.

Moreover, there is no teaching or suggestion, within Yoshinaka, of a composition having a blend of a polyamide resin and a lower water absorption resin. Therefore, Applicant requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims.

35 U.S.C. § 103(a) Rejection – Claims 19, 20, 43 and 44:

Claims 19, 20, 43 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,800,956 to Minemura et al. in view of Kito et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

In the present invention, as set forth in both claims 19 and 43, the resin composition “consists essentially of” a polyamide resin and an inorganic filler for reinforcement. This combination, is not disclosed, taught or suggested in the above references, either individually, or in combination. Specifically, there is no disclosure in either Minemura or Kito (individually or in combination) of a conductive resin composition which “consists essentially of” a polyamide resin and an inorganic filler for reinforcement, as set forth in both claims 19 and 43.

In view of the foregoing, Applicant submits that the above combination fails to teach or suggest each and every feature of the present invention, as set forth in claims 19 and 43. As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims. Further, as claims 20 and 44 depend on these claims, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection – Claims 21 and 45:

Claims 21 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minemura in view of Kito, in further view of the Horgan reference. However, because claims 21 and 45 depend on claims 19 and 43, respectively, and because Horgan fails to cure the deficient

teachings of the above references, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection – Claims 23, 24, 47 and 48:

Claims 23, 24, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horgan in view of U.S. Patent No. 6,312,788 to Mohri et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

As indicated previously, Horgan discloses that the electrically conductive ground strip layer comprises a film forming binder, conductive particles, crystalline silica particles dispersed in the film forming binder and a chemical reaction product of an amino-silane bi-functional coupling agent with both the film forming binder and the crystalline particles.

However, in the present invention, crystalline silica particles and a chemical reaction product of an amino silane bi-functional coupling agent are not essentially included. In the present invention, the resin composition consists essentially of polyamide resin and has a factor $\tan\delta$ in a range of 0.05 or more. It is for at least this reason that the present invention and Horgan differ from each other in both their composition and effects.

Moreover, Applicant submits that Horgan fails to disclose, teach or suggest having a base body which has a cylindrical shape and is made of a conductive resin composition. *See e.g.* claims 23 and 47. Applicant notes the Examiner's comments regarding this claim feature. Namely, the Examiner indicated that this feature was entitled to no patentable weight. However, as shown in the previous section, Applicant has amended these claims to more positively recite this claim feature. As such, Applicant submits that Horgan fails to disclose a base body for a

photosensitive drum which has a base body having a cylindrical shape and made of a conductive resin composition which consists essentially of a polyamide resin and has a factor $\tan\delta$ in a range of 0.05 or more. *See e.g.* claims 23 and 47.

Moreover, the above deficiency of Horgan is not cured by Mohri.

In view of the foregoing, Applicant submits that the above combination fails to teach or suggest each and every feature of the present invention, as set forth in claims 23 and 47. As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims. Further, as claims 24 and 48 depend on these claims, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection – Claims 32-35:

Claims 32-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakogawa in view of Horgan. In view of the following discussion, Applicant respectfully traverses these above rejection.

As indicated previously, the Sakogawa reference discloses using a resin composition which comprises a resin and a conductive filler. The resin contains a styrene type thermoplastic elastomer and/or an olefin type thermoplastic elastomer. Therefore, regardless of the embodiment disclosed by Sakogawa a thermoplastic elastomer is used.

In the present invention, as set forth in claim 32, a polyamide resin is used. *See* claim 32. Applicant submits that it is known that a polyamide resin is different than a thermoplastic

elastomer. As such, Sakogawa's disclosure of a thermoplastic elastomer fails to disclose, teach or suggest the polyamide of the present invention.

Further, Horgan discloses that the electrically conductive ground strip layer comprises a film forming binder, conductive particles, crystalline silica particles dispersed in the film forming binder and a chemical reaction product of an amino-silane bi-functional coupling agent with both the film forming binder and the crystalline particles.

However, in the present invention, crystalline silica particles and a chemical reaction product of an amino silane bi-functional coupling agent are not essentially included. It is for at least this reason that the present invention and Horgan differ from each other in both their composition and effects. Additionally, one of ordinary skill in the art would not have been motivated to combine Horgan and Sakogawa, as suggested by the Examiner, in an effort to obtain the claimed invention. *See* claim 32.

In view of the foregoing, Applicant submits that the above combination fails to teach or suggest each and every feature of the present invention, as set forth in claim 32. As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to this claim, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of this claim. Further, as claims 33-35 depend on claim 32, Applicant submits that these claims are also allowable, at least by reason of their dependence.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/988,283

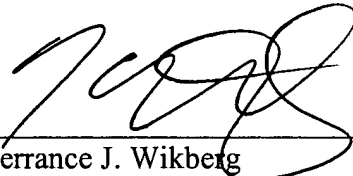
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Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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